

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 10/733,843
Attorney Docket No.: Q78446

AMENDMENTS TO THE DRAWINGS

Applicant is attaching herewith two (2) sheets of replacement drawings, which include FIGS. 4A, 4B, 5A and 5B. The legend --RELATED ART-- has been added to FIGS. 4A, 4B, 5A and 5B. The submitted replacement drawings are believed to obviate the Examiner's objection in the Office Action mailed February 9, 2005.

Attachment: Two Replacement Sheets (2)

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REMARKS

Claims 1-12 are all the claims pending in the application. By this Amendment, Applicant amends claims 1 and 11 to further clarify the invention. In addition, Applicant rewrite claim 2 into its independent form and adds claim 12. Claim 12 is clearly supported throughout the specification, *e.g.*, pages 16 and 17 of the specification.

I. Summary of the Office Action

The Examiner objected to the drawings. In addition, the Examiner rejected claim 11 under 35 U.S.C. § 112, second paragraph for improper antecedent basis and objected to claim 1 for minor informality. The Examiner also rejected claims 1, 3-6, and 8 under 35 U.S.C. § 102. Finally, the Examiner indicated that claims 2, 7, and 9-11 contain allowable subject matter.

II. Preliminary Matters

As preliminary matters, Applicant submits herewith a substitute Declaration and Assignment.

In this first Non-Final Office Action, the Examiner has acknowledged the claim to foreign priority and confirmed that the certified copy of the priority document was received. In addition, the Examiner initialed the references listed on Forms PTO/SB/08 A & B submitted with the Information Disclosure Statements filed on December 12, 2003 and May 25, 2004.

III. Objection to the Drawings

The Examiner objected to the drawings because Figs. 4A-5B are not labeled prior art. The drawings have been amended to remedy this situation. Two Replacement Drawings labeling Figs. 4A-5B related art are accompanying this response. As a result, the Examiner is respectfully

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requested to acknowledge receipt and indicate approval of the drawing corrections in the next Patent Office paper.

IV. Claim Objection

The Examiner objected to claim 1 because of a minor typographical error. The claim has been revised, and no longer include the potential informality mentioned by the Examiner. Therefore, it is appropriate and necessary for the Examiner to withdraw this objection to claim 1.

V. Rejection under 35 U.S.C. § 112, second paragraph

The Examiner rejected claim 11 under 35 U.S.C. § 112, second paragraph. Applicant has revised the claim, and respectfully submits that the claims as now presented no longer include the potential informality mentioned by the Examiner. Applicant therefore respectfully requests the Examiner to withdraw this rejection of claim 11.

VI. Rejection under 35 U.S.C. § 102

Claims 1, 3-6, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent No. 384,128 to Winthrop (hereinafter referred to as “Winthrop”). Applicant respectfully traverses this rejection in view of the following comments.

The Examiner contends that Winthrop suggests each feature of independent claim 1. This rejection is not supportable for at least the following reasons. Claims 1 is the only independent claim. Claim 1, among a number of unique features, recites: “astigmatism peaks positioned at substantially the same height as the far point or higher than the far point.”

To be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicant’s claims. Rejections under 35 U.S.C. § 102 are proper

only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention.

Winthrop teaches a lens specifically designed for near and intermediate working distances in the number example 3 (see page 12). This type of lens provides a large, stable near-viewing area, a relatively small, distance-viewing area, and a wider intermediate-viewing zone than of the general purpose lens. For a reading addition of 2.00 diopters, the maximum astigmatism of the occupational lens is 1.10. With respect to the location of the maximum astigmatism of the occupational lens, Winthrop only teaches that it is located above the 0-180° line of the lens, where it cannot interfere with the near-vision function (Figs. 13A-C; page 12, lines 4 to 29). For example, as depicted in Fig. 13B, the maximum astigmatism of 1.00 is located above the near dioptic power region but in the intermediate corridor.

In other words, Winthrop does not teach or suggest the location of the astigmatism peak being at substantial the same height or above the far point. Instead, Winthrop only teaches the astigmatism peak being above the near dioptic power region (above the 0-180° line). In summary, the deficiencies of the Winthrop reference fall to the Examiner's burden to show inherent inclusion of the claim elements. Therefore, for all the above reasons, independent claim 1 is patentable. Claims 3-6, and 8 are patentable at least by virtue of their dependency on claim 1.

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V. Allowable Subject Matter

Applicant thanks the Examiner for indicating that claims 2, 7, 9, and 10 contain allowable subject matter and would be allowable if rewritten in their independent form including all the limitations of the base claim and any intervening claims.

By this Amendment, Applicant rewrites claim 2 into its independent form. Thereby, claim 2 should be allowed. With respect to claims 7, 9, and 10, Applicant respectfully holds the rewriting of these claims in abeyance until arguments presented with respect to independent claim 1 have been considered.

VI. New Claims

In order to provide more varied protection, Applicant adds claim 12. Claim 12 is patentable at least by virtue of its dependency on claim 1.

VII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER

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Nataliya Dyorson
Registration No. 56,616

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